

REMARKS/ARGUMENTS

The Office Action mailed July 28, 2004, has been received and reviewed. Claims 1 through 72 are currently pending in the application. Claims 11, 19, 20, 29, 38 through 55, 62, 71, and 72 have been withdrawn from consideration. Claims 1 through 10, 12 through 18, 21 through 28, 30 through 37, 56 through 61, and 63 through 70 stand rejected. Applicants have amended claims 1, 21 and 56. Reconsideration is respectfully requested.

Double Patenting Rejection Based on Application No. 10/191,222 (now U.S. Patent No. 6,781,145)

Claims 1 through 3, 8, 21 through 28, 30 through 37, 56 through 61, and 63 through 70 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of Application 10/191,222 (now U.S. Patent No. 6,781,145). In addition, claims 1 through 10, and 12 through 18 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of Application 10/191,222 (now U.S. Patent No. 6,781,145), in view of U.S. Patent No. 5,057,451 to McCollum.

In order to avoid further expenses and time delay, Applicants elect to expedite the prosecution of the present application by filing a terminal disclaimer to obviate the double patenting rejections in compliance with 37 CFR §1.321 (b) and (c). Applicants' filing of the terminal disclaimer should not be construed as acquiescence in the Examiner's double patenting or obviousness-type double patenting rejections. Attached is the terminal disclaimer and accompanying fee.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 5,057,451 to McCollum

Claims 1, 3, 8, 21, 37, and 56 stand rejected under 35 U.S.C. § 102(b) as being anticipated by McCollum (U.S. Patent No. 5,057,451). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v.*

Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

McCollum discloses a method of forming an antifuse element. The antifuse element includes a substrate 10 having an N + diffusion region 12. A silicon dioxide layer 16 overlies the N + region. A thick field silicon dioxide region 24 overlies the silicon dioxide layer 16 and an upper electrode 28 is formed thereover. (McCollum, Figs. 1a-1c, col. 5, line 43 – col. 6, line 66).

By way of contrast with McCollum, independent claim 1 of the presently claimed invention recites an “integrated circuit device comprising: a first conductive layer including at least one protrusion; an insulative layer overlying the first conductive layer and exposing at least part of the at least one protrusion; and programmable resistive material in direct contact with the at least one protrusion of the first conductive layer, the programmable resistive material capable of switching between different resistive states.” Support for the amendment can be found throughout the as-filed specification, for example, paragraphs [0004] and [0010]-[0016].

Applicants respectfully submit that McCollum fails to disclose, either expressly or inherently, every element of independent claims 1, 21 and 56 of the presently claimed invention. Each of the claims 1, 21 and 56 of the presently claimed invention include similar recitation of “programmable resistive material capable of switching between different resistive states” and “the programmable resistive material in direct contact with the at least one protrusion of the first conductive layer” which is not disclosed, either expressly or inherently, by McCollum. As McCollum fails to disclose every element of claims 1, 21 or 56 of the presently claimed invention, applicants respectfully submit that McCollum cannot anticipate claims 1, 21 or 56. Therefore, claim 1 is allowable.

Claims 3 and 8 are both allowable as depending from allowable claim 1.

Claim 37 is allowable as depending from allowable claim 27.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,057,451 McCollum

Claims 2, 4 through 7, 9, 10, 12 through 18, 22 through 28, 30 through 36, 57 through 61, and 63 through 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McCollum

(U.S. Patent No. 5,057,451). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The Court of Appeals for the Federal Circuit has stated that “dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). See also MPEP § 2143.03. Having failed to teach or suggest each and every limitation of independent claims 1, 21 and 56, the prior art referenced as rendering dependent claims 2, 4 through 7, 9, 10, 12 through 18, 22 through 28, 30 through 36, 57 through 61, and 63 through 70 obvious, cannot serve as a basis for rejection.

ENTRY OF AMENDMENTS

The amendments to the claims above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 1-10, 12-18, 21-28, 30-37, 56-61 and 63-70 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Office determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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